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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/470,155 12/22/99 JING

N 55235USA2A

EXAMINER

IM52/1011

OFFICE OF INTELLECTUAL PROPERTY COUNSEL
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ART UNIT

PAPER NUMBER

1773

DATE MAILED:

10/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/470,155

Applicant(s)
JING

Examiner
Vivian Chen

Art Unit
1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7-16-01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) 8, 9, and 11-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4, 5 20) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group I in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the examination of Groups I, II, and III are require duplication of work. This is not found persuasive because while the Groups contain some common features, Groups II and III also contain features not required in Group I and therefore constitute a substantial burden with regard to examination.

The restriction requirement is still deemed proper and is therefore made FINAL.

2. Claims 12-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

3. Claims 8-9, 11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over TSE ET AL (US 5,227,426).

TSE ET AL disclose a curable adhesive composition comprising an olefin polymer with pendent functional groups such as carboxyl or amide, and catalysts such as tetrabutyl phosphonium bromide, crown ethers, and/or tetrabutyl ammonium hydroxide (columns 12-16, 23-24; lines 5-16, col. 30) as recited in claims 1-3, 5-6, 10. However, the reference does not explicitly disclose the recited combination of a base and crown ether.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to select an effective combination of known catalysts as curing agents and use a commercially available crown ether such as 18-crown-6 ether in the adhesive composition of TSE ET AL depending on the particular functional groups and base polymer used, and the curing properties, adhesive and processing characteristics required by a given application.

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6. Claims 1-4, 7, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over KUBILLUS ET AL (US 5,169,979).

KUBILLUS ET AL discloses a curable polyester composition suitable for adhesives comprising a polyester and catalysts such as sodium or potassium hydroxide, crown ethers, and/or tetrabutylammonium fluoride (lines 30-40, col. 4; lines 21-53, col. 9) as recited in claims 1-3, 7, 10. However, the reference does not explicitly disclose the recited combination of a base and crown ether.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to select an effective combination of known catalysts as curing agents and use a commercially available crown ether such as 18-crown-6 ether in the adhesive composition of KUBILLUS ET AL depending on the particular functional groups and base polymer used, and the curing properties, adhesive and processing characteristics required by a given application.

7. Claims 1-4, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over KRAFT ET AL (US 4,542,192).

KRAFT ET AL '192 discloses a curable polyester composition suitable for adhesives comprising a polyester and catalysts such as sodium or potassium hydroxide, crown ethers, and/or tetrabutylammonium fluoride (lines 1-34, col. 9; lines 1-39, col. 13) as recited in claims 1-3, 7. However, the references do not explicitly disclose the recited combination of a base and crown ether.

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to select an effective combination of known catalysts as curing agents and use a commercially available crown ether such as 18-crown-6 ether in the adhesive composition of KRAFT ET AL '192 depending on the particular functional groups and base polymer used, and the curing properties, adhesive and processing characteristics required by a given application.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

KRAFT ET AL (US 4,208,488) discloses a curable adhesive composition containing crown ethers.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday-Thursday from 8:30 AM to 6:00 PM and on alternate Fridays from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Paul Thibodeau, can be reached on (703) 308-2367.

For Art Unit 1773, the fax phone numbers are as follows:

official faxes:


(703) 305-3601
(703) 305-7718

unofficial faxes:

(703) 305-5436
(703) 305-3602

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is (703) 308-0661.

VC
October 7, 2001


Vivian Chen
Primary Examiner
Group 1700